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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,228	02/06/2001	Jonathan N. Howarth	SU-7155-A	5749

7590 05/09/2003

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EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/09/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 3/31/03

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 8-10, 18, 21-40 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 11-17, 19, 20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Applicant's election with traverses of Group I with species of 1, 3-5, 5-dimethyl, and cyanurates in Paper No. 6 is acknowledged. The traversal is on the ground(s) that great amount of time, effort and expense would result. This is not found persuasive because a great amount of time and effort would be required, an excessive burden on PTO examination.

The requirement is still deemed proper and is therefore made FINAL.

Claims 8-10, 18, and 21-40 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17.

Claims 1-5, 7, 11-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GIBARD ⁴⁵³⁷⁶⁷⁷~~479, 599~~ in view of 40 CFR 156.10, and Yerushalim et al 5780641.

Girard: 1, 3-dibromo alkyl and dimethyl hydrations (claims 1-4, 7, 8, 10, 13) in a solid granule form mixed with a biocidally inactive excipient are shown. Nothing else is required. The product is an article of manufacture for the instant uses (col. 2, top) water-cooling disinfections, and is stated to be able to be shipped (col. 3, lines 17-18). Example is refers to adding the Bromine article to water. Although no package is recited, it is well with in the purview of one in the disinfectant arts to provide a suit able package to contain, dispense and ship the article in whatever form desired. Furthermore, 40 CFR 156.10 exemplifies the requirements for labeling of compounds to be used with identification of ingredient and direction for use. Labels, instructions future

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intended use and packaging of the composition are not of patentable weight.

Comparisons with other compounds, methods of use, and intended or inherent effects resulting from the use of the article are not of patentable weight. Girard provides compositions of claim 1(ii), and also of 1(i) since in order to mix, one must have the pure compound. Mixing is shown at col. 3, last paragraph. A packaging material in fact can constitute the holding form, dosed (col. 4, top). Instant claim 2 Particle size is met, as granules, rods are an acceptable form (col. 3, lines 11-13). As of claim products recognize 3 recognized as present, if at no more than trace amounts, due to preparation as is art recognized (col. 3, lines 9-34).

Yerushalmi discloses the presence of halohydrantoin at 98.9 to 99.90, absent water, and 0.25 – 6% Biocidal inert excipient stabilizer (col. 2, lines 14-30, 40-54). And stopped in closed containers (Thus, the instant packaging material and hydantoin article. The particular hydantoin includes the instant species dibromo 5 ethyl (col. 1, lines 15-32) specified, but generically also the dimethyl form. Use is intended in cooling towers, toilets (col. 1, lines 51-67), in packaged, stable form, as powder, granule, tablet (col. 2, top). No comment is made as to instructions or labeling, except by inference to marketing and use (col. 2, lines 57-54).

It would have been obvious a person of ordinary skill in the art at the time the invention was made desiring to utilize a water disinfectant, to utilize one of Girard, with modification as required by federal agencies, exemplified by EPA requirements for Labeling, identification and dosage/use in instructions, with particular ingredients of preparation as exemplified by Yerushalmi. One having ordinary skill in the art would be

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motivated to perform this modification in order to prevent Federal and state fines, and to provide means of storing, transporting and dispensing toxic bromine containing articles.

There is no unobvious and/or unexpected results obtained since the prior art is well aware of the use of specific binders, plasticizers, fillers, thickeners, carriers toxicants and other adjuvants common to the art as a means of and the use of ingredients for the functionality for which they are known to be used is not a basis for patentability, have not been shown to be critical by applicant.

All the critical elements of the instant invention are disclosed.

The selection of each ingredient is a result effective parameter chosen to obtain the desired effects. It would be obvious to vary the nature of each ingredient to optimize the effects desired, such as control of specific.

Applicant's arguments filed on 5/31/03 have been fully considered but they are not persuasive. Applicant's remarks and arguments have resulted in reconsideration necessitated by amendment. See new rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703)308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Neil S. Levy', is positioned to the right of the main text block.

Levy/LR
May 5, 2003

NEIL S. LEVY
PRIMARY EXAMINER